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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,822	04/17/2001	Hideo Ando	P 280186 T4YK-01S0040	5555
909	7590	08/26/2004	EXAMINER	
PILLSBURY WINTHROP, LLP			SHERR, CRISTINA O	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	

3621

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/835,822

Applicant(s)

ANDO ET AL.

Examiner

Cristina O Sherr

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>June 4, 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to the Applicant's amendment filed May 26 , 2004. Claims 1-16 have been canceled. Claims 17-26 are newly added in this case. Claims 17-26 are pending in this case.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on June 4, 2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

Response to Arguments

3. Applicant's arguments with respect to claim 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

5. Claims 18, 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically claims 18 and 19 are dependent on claim 1 and claim 20 is dependent on claim 3. Since claims 1 and 3 have been previously canceled, claims 18-20 are improper. Correction of these claims is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 17 and 21-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Nabeshima et al (US 5,587,991A).

8. Regarding claim 17 –

Nabeshima discloses an information reproducing apparatus used in a transmitting/receiving system comprising a transmitting side and a receiving side, said transmitting side including means for transmitting information to be transmitted together with corresponding transmission time information; and means for transmitting n time information continuously after transmission of the transmitting information to be transmitted is ended, said receiving side including: means for reproducing received information which is the information to be transmitted, and reproducing the transmission time information; means for temporarily storing the received information as the stored information and the transmission time information as the stored transmission time information when the reproduction is interrupted; means for obtaining a time difference between the stored transmission time information and the received transmission time information when the interruption is released; and means for making a reproduction of the stored information if the time difference is less than a predetermined value, and means for executing charging of pay information in accordance with a value of the time difference (e.g. col 2 ln 17-col 3 ln 38).

9. Regarding claim 21 –

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Nabeshima discloses an information reproducing method used in a transmitting/receiving system including a transmitting side and a receiving side, comprising steps of in said transmitting side, transmitting information to be transmitted together with corresponding transmission tune information; and transmitting transmission time information continuously after a session of the transmitting information to be transmitted is ended, in the receiving side, reproducing received information which is the information to be transmitted, and reproducing the transmission time information; temporarily storing the received information as the stored information and the transmission time information as the stored tune information when the reproduction is interrupted; obtaining a time difference between the stored transmission time information and the received transmission time information when the interruption is released; and making a reproduction of the stored information if the time difference is less than a predetermined value, and executing charging of pay information in accordance with the value of the time difference (e.g. col 3 ln 26-37).

10. Regarding claim 22 –

Nabeshima discloses an information reproducing apparatus for a transmitting/receiving system having a transmitting side and a receiving side, comprising: on the transmitting side, a transmitting portion which transmits information to be transmitted together with corresponding transmission time information and which continues to transmit the transmission time information after completing the transmission of the information to be transmitted; on the receiving side, a reproducing portion which receives the information to be transmitted and the transmission time information and reproduces the information

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to be transmitted and the transmission time information; a storing portion which temporarily stores the information to be transmitted as stored information to be transmitted and the transmission time information as stored transmission time information when reproduction is interrupted; a time-difference-obtaining portion which obtains a time difference between the stored transmission time information and transmission time information received after tire interruption is terminated; and a conditional-reproduction portion which reproduces the stored information to be transmitted if the time difference is less than a predetermined value; and a charging portion which executes charging of pay information in accordance with a value of the time difference (e.g. col 3 ln 49-60).

11. Regarding claim 23 –

Nabeshima discloses an apparatus according to claim 22, further comprising a warning portion which provides a warning in sound or in pictures on a display if the time difference exceeds the predetermined value (e.g. col 2 ln 17-col 3 ln 38).

12. Regarding claim 24 –

Nabeshima discloses an apparatus according to claim 22, wherein the received information to be transmitted and the received transmission time information are stored in the storing portion in an encrypted state (col 2 ln 17-col col 3 ln 38).

13. Regarding claim 25 –

Nabeshima discloses an apparatus according to claim 24, wherein the received information to be transmitted includes encrypted television signals (e.g. col 3 ln 49-60).

14. Regarding claim 26 –

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Nabeshima discloses an information reproducing method for a transmitting/receiving system having a transmitting side and a receiving side, comprising: on the transmitting side, transmitting information to be transmitted together with corresponding transmission time information and continuing to transmit the transmission time information are completing transmission of the information to be transmitted; on the receiving side, receiving the information to be transmitted and the transmission time information and reproducing the information to be transmitted and the transmission time information; temporarily storing the information to be transmitted as stored information to be transmitted and the transmission time information as stored transmission time information when interruption occurs in reproduction; obtaining a time difference between the stored transmission time information and transmission time information received after the interruption ends; and making a reproduction of the stored information to be transmitted if the time difference is less than a predetermined value; and executing charging of pay information in accordance with a value of the time difference (e.g. col 3 ln 26-37).

15. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina O Sherr whose telephone number is 703-305-0625. The examiner can normally be reached on Monday through Friday 8:30 to 5:00.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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